

# PATENT COOPERATION TREATY

TOLER LARSON & *h*  
REC FEB 23 2005 VD

From the INTERNATIONAL SEARCHING AUTHORITY

To:  
JEFFREY G. TOLER  
5000 PLAZA ON THE LAKE  
SUITE 265  
AUSTIN, TX 78746

**PCT** ABEL LLP

NOTIFICATION OF TRANSMITTAL OF  
THE INTERNATIONAL SEARCH REPORT AND  
THE WRITTEN OPINION OF THE INTERNATIONAL  
SEARCHING AUTHORITY, OR THE DECLARATION

(PCT Rule 44.1)

Applicant's or agent's file reference SS00355-WO	Date of mailing (day/month/year) <b>17 FEB 2005</b>
International application No. PCT/US04/34239	International filing date (day/month/year) 15 October 2004 (15.10.2004)
Applicant SBC KNOWLEDGE VENTURES, L.P.	

1. ☒ The applicant is hereby notified that the international search report and the written opinion of the International Searching Authority have been established and are transmitted herewith.  
  
**Filing of amendments and statement under Article 19:**  
 The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):  
  

**When?** The time limit for filing such amendments is normally two months from the date of transmittal of the international search report.  
  
**Where?** Directly to the International Bureau of WIPO, 34 chemin des Colombettes  
 1211 Geneva 20, Switzerland, Facsimile No.: +41 22 740 14 35  
  
 For more detailed instructions, see the notes on the accompanying sheet.
2. ☐ The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect and the written opinion of the International Searching Authority are transmitted herewith.
3. ☐ With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:
 

☐ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.  
☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.
4. **Reminders**  
 Shortly after the expiration of 18 months from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90bis.1 and 90bis.3, respectively, before the completion of the technical preparations for international publication.  
  
 The applicant may submit comments on an informal basis on the written opinion of the International Searching Authority to the International Bureau. The International Bureau will send a copy of such comments to all designated Offices unless an international preliminary examination report has been or is to be established. These comments would also be made available to the public but not before the expiration of 30 months from the priority date.  
  
 Within 19 months from the priority date, but only in respect of some designated Offices, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later); otherwise, the applicant must, within 20 months from the priority date, perform the prescribed acts for entry into the national phase before those designated Offices.  
  
 In respect of other designated Offices, the time limit of 30 months (or later) will apply even if no demand is filed within 19 months.  
  
 See the Annex to Form PCT/IB/301 and, for details about the applicable time limits, Office by Office, see the *PCT Applicant's Guide*, Volume II, National Chapters and the WIPO Internet site.

Name and mailing address of the ISA/ US  
Mail Stop PCT, Attn: ISA/US  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
Facsimile No. (703) 305-3230

Authorized officer

Emmanuel L. Moise

**DOCKETED**  
Telephone No. (703) 305-3900

Form PCT/ISA/220 (January 2004)

DATE: 02-24-2005

BY: *Ja*

(See notes on accompanying sheet)

## PATENT COOPERATION TREATY

## PCT

## INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

ABEL LLP  
DA 9002 8 2 034 138  
8 NUSAN 8 701

Applicant's or agent's file reference SS00355-WO	<b>FOR FURTHER ACTION</b> see Form PCT/ISA/220 as well as, where applicable, item 5 below.	
International application No. PCT/US04/34239	International filing date (day/month/year) 15 October 2004 (15.10.2004)	(Earliest) Priority Date (day/month/year) 05 November 2003 (05.11.2003)
Applicant SBC KNOWLEDGE VENTURES, L.P.		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 2 sheets.

☒ It is also accompanied by a copy of each prior art document cited in this report.

## 1. Basis of the Report

- a. With regard to the language, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ The international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

- b. ☐ With regard to any nucleotide and/or amino acid sequence disclosed in the international application, see Box No. I.

2. ☐ Certain claims were found unsearchable (See Box No. II)

3. ☐ Unity of invention is lacking (See Box No. III)

4. With regard to the title,

☒ the text is approved as submitted by the applicant.

☐ the text has been established by this Authority to read as follows:

5. With regard to the abstract,

☒ the text is approved as submitted by the applicant.

☐ the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box No. IV. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. With regard to the drawings,

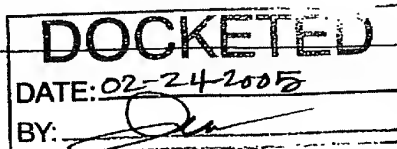
- a. the figure of the drawings to be published with the abstract is Figure No. 1

☒ as suggested by the applicant.

☐ as selected by this Authority, because the applicant failed to suggest a figure.

☐ as selected by this Authority, because this figure better characterizes the invention.

- b. ☐ none of the figures is to be published with the abstract.



## INTERNATIONAL SEARCH REPORT

International application No.

PCT/US04/34239

## A. CLASSIFICATION OF SUBJECT MATTER

IPC(7) : H04M 3/42

US CL : 455/417

According to International Patent Classification (IPC) or to both national classification and IPC

## B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

U.S. : 455/417

Documentation searched other than minimum documentation to the extent that such documents are included in the field

Electronic data base consulted during the international search (name of data base and, where practicable, search terms)  
EAST

## C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X --- Y, P	US 2003/0039242 A1 (MOORE, JR.) 27 February 2003 (27.02.2003), paragraphs 29, 30, 32, 34, 38, 43, 44  US 2004/0156491 A1 (REDING et al.) 12 August 2004 (12.08.2004), paragraphs 32, 43, 44	1-3, 5-7, 14-15  4, 8-13
X --- Y	US 2002/0181442 A1 (RAJANI) 05 December 2002 (05.12.2002), paragraphs 43, 48, 50, 53, 54  US 2003/0039242 A1 (MOORE, JR.) 27 February 2003 (27.02.2003), paragraphs 29, 30, 34, 39, 48	14-15  16-18



Further documents are listed in the continuation of Box C.



See patent family annex.

## \* Special categories of cited documents:

"A"	document defining the general state of the art which is not considered to be of particular relevance	"T"	later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
"B"	earlier application or patent published on or after the international filing date	"X"	document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
"L"	document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	"Y"	document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
"O"	document referring to an oral disclosure, use, exhibition or other means	"&"	document member of the same patent family
"P"	document published prior to the international filing date but later than the priority date claimed		

Date of the actual completion of the international search

04 February 2005 (04.02.2005)

Name and mailing address of the ISA/US

Mail Stop PCT, Attn: ISA/US  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Facsimile No. (703) 305-3230

Date of mailing of the international search report

17 FEB 2005

Authorized officer

Emmanuel L. Moise

Telephone No. (703) 305-3900

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:  
JEFFREY G. TOLER  
5000 PLAZA ON THE LAKE  
SUITE 265  
AUSTIN, TX 78746

## PCT

### WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Applicant's or agent's file reference  SS00355-WO		Date of mailing (day/month/year) <b>17 FEB 2005</b> <b>FOR FURTHER ACTION</b> See paragraph 2 below	
International application No.	International filing date (day/month/year)	Priority date (day/month/year)	
PCT/US04/34239	15 October 2004 (15.10.2004)	05 November 2003 (05.11.2003)	
International Patent Classification (IPC) or both national classification and IPC			
IPC(7): H04M 3/42 and US Cl.: 455/417			
Applicant			
SBC KNOWLEDGE VENTURES, L.P.			

1. This opinion contains indications relating to the following items:

- ☒ Box No. I      Basis of the opinion
- ☐ Box No. II      Priority
- ☐ Box No. III      Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV      Lack of unity of invention
- ☒ Box No. V      Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI      Certain documents cited
- ☐ Box No. VII      Certain defects in the international application
- ☐ Box No. VIII      Certain observations on the international application

#### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US Mail Stop PCT, Attn: ISA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703) 305-3230	Authorized officer  Emmanuel L. Moise Telephone No. (703)305-3900
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WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/US04/34239

Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ This opinion has been established on the basis of a translation from the original language into the following language \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

- ☐ a sequence listing  
☐ table(s) related to the sequence listing

b. format of material

- ☐ in written format  
☐ in computer readable form

c. time of filing/furnishing

- ☐ contained in international application as filed.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

WRITTEN OPINION OF THE  
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Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims <u>NONE</u>	YES
	Claims <u>1-3, 5-7, 14-15</u>	NO
Inventive step (IS)	Claims <u>NONE</u>	YES
	Claims <u>1-18</u>	NO
Industrial applicability (IA)	Claims <u>1-18</u>	YES
	Claims <u>NONE</u>	NO

2. Citations and explanations:

Please See Continuation Sheet

**WRITTEN OPINION OF THE  
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**Supplemental Box**

In case the space in any of the preceding boxes is not sufficient.

**V. 2. Citations and Explanations:**

1. Claims 1-3, 5-7 lack novelty under PCT Article 33(2) as being anticipated by Moore, Pub. No. US 2003/0039242.

Regarding claim 1, Moore discloses a method of forwarding a call from a mobile phone, the method comprising: determining that the mobile phone is within range of a wireless local area network base station with voice over internet protocol capability (i.e., the mobile handset is enabled to determine whether it is within range of the local network) (see page 2, paragraph 29 lines 9-10); receiving an internet protocol address associated with the wireless local area network base station (i.e., to enable the forwarding of telephone calls from the mobile telephone network to the VoIP telephone network, the handset may first request the telephone number of the VoIP gateway)(see page 2, paragraph 32, lines 1-4); sending a call forwarding message including the internet protocol address from the mobile phone to a remote cellular network element of a wide area cellular network (i.e., the handset sends a command to the mobile telephone network) (see page 2, paragraph 32, line 5).

Regarding claim 2, Moore discloses a method (see claim 1 rejection), wherein the cellular network redirects a call destined to the mobile phone to the wireless local area network base station for communication with the mobile phone using the voice over Internet protocol (i.e., the mobile handset sends a command to the mobile telephone network instructing the mobile telephone network to forward incoming telephone calls to a telephone number of the VoIP gateway via the VoIP telephone network) (see page 3, paragraph 34, lines 3-8).

Regarding claim 3, Moore discloses a method (see claim 1 rejection), wherein the mobile phone determines that it is in the range of the wireless local area network by receiving a message in accordance with 802.11 communication protocol (i.e., a processor is provided for determining whether the mobile handset is within range of the local network, which is in accordance with the 802.11 communication protocol) (see page 2, paragraph 19; and page 3, paragraph 44).

Regarding claim 5, Moore discloses a method (see claim 1 rejection), further comprising determining that the mobile phone has moved out of range of the wireless local area network base station and sending a message to the cellular network element to cancel call forwarding to the wireless local area network base station (i.e., the handset is enabled to determine whether it is within range of the local network. And, the forwarding of telephone calls may be disabled when the handset is outside the range of the local network) (see page 2, paragraphs 29, and 30).

Regarding claim 6, Moore discloses a method (see claim 1 rejection), wherein the wide area cellular network sends a call directly to the mobile phone over the cellular spectrum after the mobile phone has moved out of range of the wireless local area network base station (i.e., if the handset is outside of the range of the local network, data traffic may be routed to and from the handset via the mobile telephone network) (see page 2, paragraph 29, lines 13-15).

Regarding claim 7, Moore discloses a method (see claim 2 rejection), wherein the mobile phone and the wireless local area network base station communicate bidirectionally using the voice over Internet protocol (i.e., a VoIP gateway for the VoIP telephone network. A cable modem allows communication between the mobile handset and the VoIP telephone network. Also, data traffic may be routed to and from the handset via the VoIP telephone network) (see page 2, paragraph 29).

2. Claims 14-15 lack novelty under PCT Article 33(2) as being anticipated by Rajani, Pub. No. US 2002/0181442  
Regarding claim 14, Rajani discloses a mobile (i.e., PCD) comprising a housing (see page 5, paragraph 53); an antenna

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PCT/US04/34239

**Supplemental Box**

In case the space in any of the preceding boxes is not sufficient.

attached to the housing (i.e. RF antenna) (see page 4, paragraph 43); a wide area cellular communications module disposed within the housing, the wide area cellular communications module having a cellular interface to communicate with a remote wide area cellular network (i.e., the MCD includes both the switching and routing functions in the housing) (see page 6, paragraphs 53-54); and a short-range wireless local area network module disposed within the housing, the short-range wireless local area network module having a wireless interface to communicate with a wireless local area network having voice over internet protocol communications capability (page 5, paragraph 50, lines 22-30).

Regarding claim 15, Rajani discloses a mobile phone (see claim 14 rejection), wherein the wide area cellular communications module and the short-range wireless local area network module are computer software modules integrated within a digital processor device (page 5, paragraph 48).

3. Claims 4, 8-13 lack an inventive step under PCT Article 33(3) as being obvious over Moore in view of Reding et al. (Reding), Pub. No. 2004/0156491.

Regarding claim 4, Moore discloses a method as described above (see claim 1 rejection).

Although Moore discloses a method as described, Moore fails to specifically disclose a method, wherein the Internet protocol address is communicated to the mobile phone using the dynamic host configuration protocol.

However, Reding discloses a method for call forwarding (see abstract), wherein a storage module includes program code and information for user terminal to communicate with service center. Storage module may include configuration information, such as a Dynamic Host Configuration Protocol (DHCP) configuration (see page 3, paragraph 43).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation for doing so would have been to reduce the work necessary to administer an IP network, as related to the distribution of the IP address.

Regarding claim 8, Moore discloses a method of communicating from a wireless local area base station to a mobile phone (see abstract), the method comprising: determining that the mobile phone is within range of the wireless local area network base station, the wireless local area network base station having voice over internet protocol communications capability (i.e., the mobile handset is enabled to determine whether it is within range of the local network) (see page 2, paragraph 29 lines 9-10); retrieving an internet protocol address associated with the wireless local area network base station from a memory (i.e., to enable the forwarding of telephone calls from the mobile telephone network to the VoIP telephone network, the handset may first request the telephone number of the VoIP gateway) (see page 2, paragraph 32, lines 1-4); and sending the internet protocol address to the mobile phone over a wireless fidelity communication link (i.e., wireless network) (see page 2, paragraph 32, lines 5-8).

Although Moore discloses a method as described above, Moore fails to specifically disclose a method comprising retrieving an optional port number associated with the wireless local area network base station, and sending the optional port number over a wireless fidelity communication link.

However, Reding discloses a method of communicating from a wireless local area base station to a mobile phone, wherein a network interface provides a communications interface between user terminal and data network. The network interface may receive and transmit communications for user terminal. The network interface may be a local area network port, or a wireless data port (see pages 3 and 4, paragraph 44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation for doing so would have been to insure the authentication of the communication process.

Regarding claim 9, Moore discloses a method (see claim 8 rejection), further comprising receiving a call from a wide area network, the call directed to the mobile phone at the internet protocol address and the optional port number of the VoIP provider (i.e., the mobile handset sends a command to the mobile telephone network instructing the mobile telephone network to forward incoming telephone calls to a telephone number of the VoIP gateway via the VoIP telephone network) (see page 3, paragraph 34, lines 3-8).

Although Moore discloses a method as described above, Moore fails to specifically disclose a method comprising an optional port number of the VoIP provider where the call may be directed.

However, Reding discloses a method of communicating from a wireless local area base station to a mobile phone, wherein a network interface, which may provide a communications interface between user terminal and data network, may be a local area network port, or a wireless data port (see page 3-4, paragraph 44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings as disclosed by Moore with the teachings as disclosed by Reding to arrive at the claimed invention. A motivation to do so would have been to insure the authentication of the communication process.

Regarding claim 10, Moore discloses a method as disclosed above (see claim 9 rejection).

Although Moore discloses a method as described above, Moore fails to specifically disclose a method, wherein the wide area network is a distributed computer network.

However, Reding discloses a method of communicating from a wireless local area base station to a mobile phone, wherein the wide area network is a distributed computer network (i.e., a network which consist of clients and servers connected in such a way that any system can potentially communicate with any other system) (see page 2, paragraph 32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings as disclosed by Moore with the teachings as disclosed by Reding to arrive at the claimed invention. A motivation to do so would have been to distribute processing to inexpensive system, and to relieve servers of many tasks.



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INTERNATIONAL SEARCHING AUTHORITY**

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PCT/US04/34239

**Supplemental Box**

In case the space in any of the preceding boxes is not sufficient.

Regarding claim 11, Moore discloses a method (see claims 8, 9 rejections), wherein the wide area network includes a high speed wired communication channel (see page 2, paragraph 30).

Regarding claim 12, Moore discloses a method (see claims 8, 9, and 11 rejections), wherein the high speed wired communication channel is a digital subscriber line connection (i.e., Broadband connection) (see page 3, paragraph 38).

Regarding claim 13, Moore discloses a method (see claims 8 rejection), further comprising establishing a bidirectional communication path between the wireless local area network base station and the mobile phone and communicating using voice over internet protocol over the bidirectional communication path (i.e., a VoIP gateway for the VoIP telephone network. A cable modem allows communication between the mobile handset and the VoIP telephone network. Also, data traffic may be routed to and from the handset via the VoIP telephone network) (see page 2, paragraph 29).

4. Claims 16-18 lack an inventive step under PCT Article 33(3) as being obvious over Rajani, in view of Moore.

Regarding claim 16, Rajani discloses a mobile phone as described above (see claim 15 rejection).

Although Rajani discloses a mobile phone as described in the referring objection, Rajani fails to specifically disclose a mobile phone further comprising a memory coupled to the digital processor device, the memory storing an Internet protocol address received by the mobile phone from the wireless local area network.

However, Moore discloses a mobile phone (i.e. mobile handset) wherein the data traffic comprises Internet Protocol (IP) data traffic. The IP data traffic may be forwarded from the mobile telephone network to the VoIP telephone network when the handset is within range of the local network. IP routers may be notified of a new route for the handset's IP address to enable the forwarding of the IP data traffic via the VoIP telephone network (see page 3, paragraph 39). One skilled in the art would have unhesitatingly conceptualized that the mobile handset inherently comprise of a memory (as known in the art of wireless communications), in which the IP address is stored.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings, which are analogous, to arrive at the claimed invention. A motivation to do so, would have been to ensure the security of the communication process.

Regarding claim 17, Rajani discloses a mobile phone as described above (see claim 16 rejection).

Although Rajani discloses a mobile phone comprising of a memory (inherent), Rajani fails to disclose a mobile phone, wherein the wide area cellular communication module formulates a call forwarding message that includes the internet protocol address, the call forwarding message to be communicated to the remote wide area cellular network.

However, Moore discloses a disclose a mobile phone (i.e. mobile handset), wherein the wide area cellular communication module formulates a call forwarding message that includes the internet protocol address, the call forwarding message to be communicated to the remote wide area cellular network (i.e., the mobile handset sends a command to the mobile telephone network instructing the mobile telephone network to forward incoming telephone calls to a telephone number of the VoIP gateway via the VoIP telephone network) (see page 3, paragraph 34, lines 3-8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation to do so would have been to insure the authentication of the communication process.

Regarding claim 18, Reding discloses a mobile phone as described above (see claim 17 rejection).

Although Rajani discloses a mobile phone as described above, Rajani fails to specifically disclose a mobile phone device, wherein the wide area cellular communication module formulates a message to cancel the previously communicated call forwarding message to be sent to the remote wide area cellular network.

However, Moore discloses mobile phone device, wherein the wide area cellular communication module formulates a message to cancel the previously communicated call forwarding message to be sent to the remote wide area cellular network (i.e., the handset is enabled to determine whether it is within range of the local network. And, the forwarding of telephone calls may be disabled when the handset is outside the range of the local network) (see page 2, paragraphs 29, and 30).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation for doing so would have been to ensure the authentication of the communication process when the mobile phone is outside a predetermined range.

## NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the *PCT Applicant's Guide*, a publication of WIPO.

In these Notes, "Article," "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

### INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

#### What parts of the international application may be amended ?

Under Article 19, only the claims may be amended

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Preliminary Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

**When ?** Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

#### Where not to file the amendments ?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

**How ?** Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

#### What documents must/may accompany the amendments ?

##### Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.

## NOTES TO FORM PCT/ISA/220 (continued)

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

The following examples illustrate the manner in which amendments must be explained in the accompanying letter:

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:  
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:  
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:  
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or  
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:  
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

### "Statement under Article 19(1)" (Rule 46.4)

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

It must be in the language in which the international application is to be published.

It must be brief, not exceeding 500 words if in English or if translated into English.

It should not be confused with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It may not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

### Consequence if a demand for international preliminary examination has already been filed

If, at the time of filing any amendments and any accompanying statement, under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the time of filing the amendments (and any statement) with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments (and of any statement) and, where required, a translation of such amendments for the procedure before that Authority (see Rules 55.3(a) and 62.2, first sentence). For further information, see the Notes to the demand form (PCT/IPEA/401).

### Consequence with regard to translation of the international application for entry into the national phase

The applicant's attention is drawn to the fact that, upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see the *PCT Applicant's Guide*, Volume II.